REMARKS/ARGUMENTS

Claims 1-20 are pending in the application. Claims 1-20 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,298,060 by Miyakawa et al. (hereinafter referred to as "Miyakawa"). In the present amendment, Applicants amend Claim 9 to correct a typographical error. Applicants present new claim 21.

35 U.S.C. §103 Rejections

The Examiner has rejected claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over Miyakawa. The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant"s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2142, 2143.

Applicants respectfully submit that all three basic criteria are missing in the rejection presented by the Examiner. With reference to Applicants' claimed invention, please refer to the originally filed specification, Summary of the Invention.

The claimed invention is directed to a method of informing a PDSN of the number and identities of network connections to be established for a newly arriving mobile station. In one embodiment, a mobile station informs a packet data services network of dormant network connections associated with the mobile station when the mobile station moves from a first infrastructure element of the packet data services network to

a second infrastructure element of the packet data services network. The method includes transmitting from the mobile station a message including a number of dormant network connections associated with the mobile station and a list of identifiers associated with the dormant network connections.

In one embodiment the network connections are Internet Protocol (IP) instances, such as Point-to-Point Protocol (PPP) connections. To avoid loss of packets of data communicated via the PPP connection, the mobile station sends a message identifying the PPP instances to establish.

With respect to claim 1, pending as:

A method of informing a packet data services network of dormant network connections associated with a mobile station when the mobile station moves from a first infrastructure element of the packet data services network to a second infrastructure element of the packet data services network, the method comprising the step of:

transmitting from the mobile station a message including a number of dormant network connections associated with the mobile station and a list of identifiers associated with the dormant network connections.

Miyakawa fails to teach all the limitations of claim 1. In contrast to Applicants' claimed invention, Miyakawa teaches a method for maintaining at the network a list of location data corresponding to potential "communication media" for a given mobile station. The communication media of Miyakawa are illustrated in FIG. 1, element 200, wherein communication media include modem, adapter for portable telephone, LAN card (Ethernet), etc. Miyakawa allows a subscriber to move between the various media by storing a Location and Preference Register (LPR) within the network. The information is maintained and used within the network.

The subscriber in Miyakawa sends a request to a new B-unit identifying a target destination or N-unit. The B-unit then retrieves the necessary information from the LPR. The subscriber in Miyakawa does not transmit a message to the network identifying a number of dormant connections. Nor does the subscriber in Miyakawa provide a list of such connections to the network. Rather, the network maintains a list of communication media and associated data as given in the list above. See Miyakawa col. 8, lines 49-55.

In Miyakawa, each subscriber has a "media dependent" identifier called the "Terminal ID." The Terminal ID changes for each communication medium. See Miyakawa col. 9, ll. 56-58, col. 9, ll. 11-17, and FIG. 1. See also Miyakawa col. 4, ll. 6-7. As detailed, the relay network 100 includes the LPR 120 to store an entry for each potential communication medium. Each entry identifies, for each potential communication medium:

Terminal ID;

Relay ID (B-unit identifier);

Priority level; and

Communication media available.

Miyakawa does not teach all of the limitations of Applicants' claimed invention, neither does Miyakawa suggest a modification of the system taught therein so as to result in Applicants' claimed invention. Specifically, Miyakawa teaches a network maintaining information relating to potential communication media for a given subscriber. Such potential communication media are not dormant network connections as defined in Applicants' specification. See Applicants' specification, page 9, lines 30-31.[1] Applicants' claimed invention recites a dormant network connection as defined in Applicants' specification, i.e., session instances, such as PPP instances, which are not being used to transmit data.

[1] The communication media of Miyakawa are described as having a signaling layer and a data layer. In other words, the communication media describes the physical layer connection.

Miyakawa does not teach the subscriber or mobile station providing dormant connection information to the network. Rather, in Miyakawa when a subscriber requests a connection with a different B-unit, the B-unit retrieves the necessary communication media information that is stored in the network. Miyakawa fails to teach the mobile station transmitting a message including a number of dormant network connections. Further, Miyakawa fails to teach the mobile station transmitting a message including a list of dormant network connection identifiers.

While the system of Miyakawa allows a user to change communication media smoothly, Miyakawa does not teach or suggest a method whereby a mobile station provides dormant network connection information to the packet data service network. Therefore, Miyakawa does not teach all of the limitation of Applicants' claims; Miyakawa does not provide suggestion or motivation to make such modification as to provide a system and method as in Applicants' claims, and there is therefore, no reasonable expectation of success is providing such a system and method. Applicants respectfully submit that a prima facie case of obviousness does not stand. Applicants respectfully request withdrawal of the rejection and allowance of the pending claims.

The arguments given hereinabove for claim 1 are applicable to the other pending claims.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicants submit that all pending claims 1-20 in the application and new claim 21 are patentable. Accordingly, reconsideration and allowance of this application is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

Dated: July 30, 2003 By: Sandra L. Godsey

Sandra L. Godsey
Attorney for Applicants
Reg. No. 42,589

QUALCOMM Incorporated
5775 Morehouse Drive
San Diego, California 92121
Telephone: (858) 651-4517
Facsimile: (858) 658-2502